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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/801,187	03/08/2001	Kazuyuki Yokokawa	67134-5071	4101

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JEFFER, MANGELS, BUTLER & MARMARO, LLP  
1900 AVENUE OF THE STARS, 7TH FLOOR  
LOS ANGELES, CA 90067

EXAMINER
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AHMAD, NASSER

ART UNIT	PAPER NUMBER
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1794

MAIL DATE	DELIVERY MODE
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01/28/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/801,187

Applicant(s)

YOKOKAWA, KAZUYUKI

Examiner

Nasser Ahmad

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 181-186, 188-194, 197-212, 214-234, 236-254, 256-264 and 269-271 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 181-186, 188-194, 197-212, 214-234, 236-254, 256-264 and 269-271 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Rejection Withdrawn***

1. Claims 265-268 are rejected under 35 U.S.C. 112, first paragraph, made in the Office Action of 5/3/2007 has been withdrawn in view of the amendment 11/2/2007 (cancelling said claims 265-268).

### ***Rejections Maintained***

2. Claims 181-186, 188-194, 197-212, 214-234, 236-264, 269-271 are rejected under 35 U.S.C. 102(e) as being anticipated by Mihara (6380132) for reasons of record made in the Office Action of 5/3/2007.

### ***Response to Arguments***

3. Applicant's arguments filed 11/2/2007 have been fully considered but they are not persuasive.

Applicant argues that *On pages 4 - 6 of the final Office Action, the Examiner held that a number of claim features were not "positive limitations" because they only "require the ability to so perform." He then accorded those features no patentable weight. He did not contend that those features presented 112, 102 or 103 issues, he simply dismissed them.* This is not found to be convincing because first, it is unclear if by the phrase "final Office Action" hereinabove, applicant is referring to the Office Action of 2/21/2007 or that of 5/3/2007.; second, applicant is directed to the Office Action of 5/3/2007, page-5, wherein said alleged phrases, and not features, were not simply dismissed, rather it

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has been clearly explained that said phrases do not affect the structure of the claimed product.

Applicant should note that phrases such as being constructed and adapted to cause (claim 181), being selected and constructed ... can be bent (claim 200), being structurally capable of (claim 242) are directed to an intended use of the claimed product structure.

In response to applicant's argument that *In re Hutchison* is clearly not on point because the claim language is in the preamble, while the claim language at issue is in the body of the claim, and that *Hutchison's* claim language states potential uses of the claimed material, examiner acknowledges that applicant is correct to note that the claim language in *Hutchison* states potential uses for the claimed material, which is deemed to be the same for the claim language at issue because of the use of phrases such as being constructed and adapted to cause, being selected and constructed ... can be bent, structurally capable of, etc. are also language that are directed to potential uses of the claimed product.

In page 16 of 23 of the amendment filed on 11/2/2007, applicant emphasizes that *the claim language at issue in the present application is not in the preamble, but rather in the body of the claim*. With this mind, applicant is informed that the cases cited in pages 16 of 23 and the nine opinions of the Board of Appeals and interferences listed in pages 17 of 23 and 18 of 23, are not directed to label sheet construction. Applicant is also reminded that the "technique" (as alleged by the applicant) used by the Examiner also

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involved considering all limitations in the claims at issue and the phrases that are not found to be of positive limitations were not given patentable weight because said phrases are directed to potential uses of said claimed product. Further, contrary to applicant's position, the phrases at issue are directed to language as to what it will do and not what it does.

Applicant's argument in page 20 of 23 is noted and regarding the citation of *Hoffer* and *Minton* is noted. However, said cases are not directed to language at issue.

Regarding applicant's request for response to the Declaration by Dr. Ugolick, that was submitted with the previous Amendment of 2/21/2007, applicant is directed to the explanations provided in the Office Action of 5/3/2007. Further, with respect to the points (a)-(g), applicant is informed that all of said points have been addressed in the previous Office Actions and apply *a fortiori* herein. For example, see Office Action of 5/3/2007, paragraph-9, clearly explains (for claim 181) the depth of the cut line, the width of the cut line, there is no breakable layer/properties of the top layer as claim 181 recites a first and a second layer as part of the claimed structure, etc.

Applicant points out that the instant application has received eight Office Actions. In response, applicant is reminded that Office Actions included response to two RCEs, and declarations that were considered

Thus, in the absence of any evidence to the contrary, it remains the examiner's position that the claimed invention is anticipated by the prior art of record as discussed.

***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Nasser Ahmad  
Primary Examiner  
Art Unit 1794  
1/22/08

N. Ahmad.  
January 22, 2008.

  
RENA DYE  
SUPERVISORY PATENT EXAMINER  
AU 1794